

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of)
Jimmy Randolph Lewis, et al.) Examiner: Jeffery A. Shapiro
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Application No.: 09/754,762) Art Unit: 3653
)
Filed : January 4, 2001) Confirmation no.: 3783
)
For: Method and Apparatus for Filling)
Stock Orders)

**REQUEST FOR RECONSIDERATION AND WITHDRAWAL OF HOLDING
OF FINALITY OR, IN THE ALTERNATIVE,
PETITION TO WITHDRAW HOLDING OF FINALITY**

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants respectfully request that the holding of finality of the official action dated November 13, 2006, be reconsidered and withdrawn.

The present application was filed on January 4, 2001 with 36 claims, claims 1, 7, 18, 29, and 33 being independent claims. Subsequent prosecution reduced the original claims to 7, 8, 10-19, and 21-28 on May 24, 2004, with claims 7 and 18 remaining independent. On October 7, 2004, a non-final Office action rejected all pending claims as being unpatentable over U.S. Patent No. 5,509,538 to Spindler in view of U.S. Patent No. 6,760,643 to Lipps and further in view of U.S. Patent No. 5,685,098 to Wergzyn. The applicants successfully traversed these rejections without amendment in a response dated October 7, 2004.

An April 29, 2005 non-final Office action rejected all claims as unpatentable over the previous references and further in view of U.S. Patent No. 5,720,154 to Lasher. However, after an interview, the Examiner withdrew the April 29, 2005 rejection and issued another non-final Office action on October 20, 2005, rejecting all pending claims as being anticipated by U.S. Patent No. 6,650,225 to Bastion. The applicants again successfully traversed these rejections on September 1, 2006 without amendment.

Another non-final rejection issued on April 5, 2006. This action rejected claims 7, 8, 10-19, and 21-28 as unpatentable over Bastion in view of Japanese Patent JP 2000-18641 to Takizawa. The applicant presented a response on September 1, 2006 that included a declaration under 37 C.F.R. § 1.131 effectively swearing behind the Takizawa reference. Again, the applicants successfully traversed the rejections without amendment.

A final rejection was mailed on November 13, 2006 rejecting all pending claims as allegedly being anticipated by exhibits provided in support of the declaration under 37 C.F.R. § 1.131 and U.S. Patent No. 6,205,396 to Teicher (hereinafter “Teicher”).

In sum, the applicants have not amended any of the pending claims 7, 8, 10-19, and 21-28 since the May 24, 2004 amendment. Further, none of the remaining claims have been rejected in either the four previous Office actions or the present final Office action under any reference provided by the applicants in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p).

The MPEP at § 706.07(a) does not allow a second or subsequent action to be made final where the examiner introduces a new ground of rejection that was neither

necessitated by the applicant's amendment nor based on information submitted by the applicant in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p). The November 13, 2006 action raises new grounds for rejection based upon information submitted in the Declaration Under 37 C.F.R. § 1.131 submitted by the applicants with the September 1, 2006 amendment and Teicher. The new rejections are not based upon amendments made by the applicant or information submitted in an information disclosure statement.

In fact, each of the new rejections under Teicher, though ultimately not sustainable, could have been made to the claims prior to the most recent September 1, 2006 "RESPONSE TO APRIL 5, 2006 OFFICE ACTION" as each claim included the element to which the examiner objects in four previous office actions. Also, Teicher was not submitted by the applicant, instead it was submitted by the examiner and then only in the most recent action. Finally, an action on the merits in any application cannot be made final "if it includes a rejection on newly cited art ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art" MPEP § 706.07(a) (emphasis added). In the September 1, 2006 "RESPONSE TO APRIL 5, 2006 OFFICE ACTION," the applicant did not amend any pending claim, yet the final action of November 13, 2006 rejected all claims in reliance on Teicher. Pursuant to MPEP §706.07(a), the finality is improper and must be withdrawn.

In short, the new grounds of rejection raised in the final office action and based on the new Teicher reference and the exhibits provided in the Declaration Under 37 C.F.R. § 1.131 were not necessitated by applicant's amendment, based on a reference

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Docket No.: 29488/36815

submitted by the applicant in an information disclosure statement, or in response to claims amended by the applicant. Therefore, the finality of the November 13, 2006 action is improper and should be withdrawn. Such withdrawal is respectfully requested.

Dated: January 31, 2007

Respectfully submitted,

By _____
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